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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* LUZ MARIA CAMACHO, ROGER D. PIRKEY,  
and MICHAEL L. HANKINSON

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Appeal 2009-006015  
Application 09/801,468<sup>1</sup>  
Technology Center 2400

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Decided: November 30, 2009

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Before KENNETH W. HAIRSTON, MARC S. HOFF, and  
BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The real party in interest is Aurora Wireless Technologies, Ltd.

## STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1, 2, 4-8, 10-16, 18-21, 23-27, 29-35, 37-40, 43, and 45-51.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We reverse, and enter a new ground of rejection.

Appellants' invention relates to a method and apparatus for reducing the occurrence of unauthorized use of on-line resources of a plurality of companies. A dynamic profile is created and/or updated for each consumer/merchant using the invention, by means of adaptive learning techniques. If the stored business rules for the company identified as associated with the requested on-line resource specify that authentication is required, indicia of physical identification are obtained from the user and compared to stored indicia. The request for on-line resources is fulfilled only if the obtained indicia match the stored indicia (Spec. 4, 8).

Claim 1 is exemplary of the claims on appeal:

1. A method for reducing the occurrence of unauthorized use of on-line resources, comprising:
  - storing business rules for a plurality of companies having on-line resources;
  - receiving a message indicating a request from a user to use on-line resources;
  - identifying a company associated with the requested on-line resource from among the plurality of companies;
  - retrieving the stored business rules for the identified company;
  - determining whether the request requires authentication;
  - enabling the request to be fulfilled without authentication if the determination indicates that authentication is not required;
  - obtaining an indicia of physical identification from the user if the determination instead indicates that authentication is required;

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<sup>2</sup> Claims 3, 9, 17, 22, 28, 36, 41, 42, and 44 have been cancelled.

comparing the obtained indicia to a stored indicia for the user; and enabling the request to be fulfilled if the obtained indicia matches the stored indicia,

wherein the step of determining whether the request requires authentication includes determining whether stored business rules for the identified company associated with the requested on-line resource indicates that authentication for the user is required.

The Examiner relies upon the following prior art in rejecting the claims on appeal:

Blonder	US 5,708,422	Jan. 13, 1998
Viavant	US 5,784,566	Jul. 21, 1998
Baulier	US 6,157,707	Dec. 5, 2000
Spiegel	US 6,466,918 B1	Oct. 15, 2002
Pereira, III	US 6,931,402 B1	Aug. 16, 2005

Claims 1, 4-6, 18-20, 23-25, 37-39, and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pereira in view of Viavant.

Claims 2, 7, 8, 21, 26, 27, 40, and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pereira in view of Viavant and Baulier.

Claims 10-16 and 29-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pereira in view of Viavant and Blonder.

Claims 46-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pereira in view of Viavant, Baulier, and Spiegel.

Throughout this decision, we make reference to the Appeal Brief ("App. Br.," filed September 25, 2006), the Reply Brief ("Reply Br.," filed February 6, 2007) and the Examiner's Answer ("Ans.," mailed December 8, 2006) for their respective details.

## ISSUE

Appellants argue that Pereira does not teach or suggest: storing business rules for a plurality of companies; identifying a company associated with the requested on-line resource from among the plurality of companies; retrieving stored business rules for the identified company; or determining whether stored business rules for the identified company associated with the requested on-line resource indicate that authentication for the user is required (App. Br. 7). The Examiner finds that these limitations are met by Pereira, because Pereira teaches controlling access per company. Pereira teaches storing rules controlling access to a specific group of objects; Pereira's database has the attribute "company" among many other attributes; and data objects may be restricted based on the "company" attribute (Ans. 7-8).

Appellants' contentions present us with the following issue:

Have Appellants shown that the Examiner erred in finding that Pereira teaches controlling access by users to on-line resources of a *plurality of companies*, including storing business rules for a plurality of companies having on-line resources; identifying a company identified with a requested on-line resource from among the plurality of companies; retrieving the stored business rules for the identified company; and determining whether stored business rules for the identified company associated with the requested on-line resource indicate that authentication for the user is required?

## FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

### *The Invention*

1. According to Appellants, they have invented a method and apparatus for reducing the occurrence of unauthorized use of on-line resources of a plurality of companies. A dynamic profile is created and/or updated for each consumer/merchant using the invention, by means of adaptive learning techniques. If the stored business rules for the company identified as associated with the requested on-line resource specify that authentication is required, indicia of physical identification are obtained from the user and compared to stored indicia. The request for on-line resources is fulfilled only if the obtained indicia match the stored indicia (Spec. 4, 8).

### *Pereira*

2. Pereira teaches providing an extranet user access to an object located in a foreign intranet (col. 3, ll. 20-21).

3. To reduce the replication of profile records across intranets, the inventive profiling database may include records for users from different companies (col. 3, ll. 24-28).

### *Viavant*

4. Viavant teaches system and method for selecting and initiating security services (i.e., authentication) for communication across computer networks (Abstract).

*Baulier*

5. Baulier teaches reducing fraud losses by invoking one or more authentication measures based on a fraud score that indicates the likelihood of fraud for that particular call or previously stored calls (Abstract).

*Blonder*

6. Blonder teaches an automated method for alerting a customer that a transaction is being initiated and for authorizing the transaction based on a confirmation/approval by the customer thereto (Abstract).

*Spiegel*

7. Spiegel teaches a computer-implemented method for identifying popular nodes within a browse tree or other hierarchical browse structure based on historical actions of online users, and for calling such nodes to the attention of users during navigation of the browse tree (Abstract).

PRINCIPLES OF LAW

On the issue of obviousness, the Supreme Court has stated that “the obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Further, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 419-420.

The Supreme Court . . . has enunciated a definitive test to determine whether a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. *See Benson*, 409 U.S. [63] 70, 93 S.Ct. 253 ("Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines."); *Diehr*, 450 U.S. [175] 192, 101 S.Ct. 1048 (holding that use of mathematical formula in process "transforming or reducing an article to a different state or thing" constitutes patent-eligible subject matter); *see also Flook*, 437 U.S. [584] 589 n.9, 98 S.Ct. 2522 ("An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing'"); *Cochrane v. Deener*, 94 U.S. 780, 788, 24 L.Ed. 139 (1876) ("A process is . . . an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.").

*In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (footnote omitted).

The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. *See Benson*, 409 U.S. at 70, 93 S.Ct. 253. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. *See Benson*, 409 U.S. at 71-72, 93 S.Ct. 253. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. *See Flook*, 437 U.S. at 590, 98 S.Ct. 2522.

*Id.*, 545 F.3d at 961-62.



## ANALYSIS

### SECTION 103 REJECTION OF CLAIMS 1, 4-6, 18-20, 23-25, 37-39, AND 45

Claims 1, 20, and 39 constitute all the independent claims in this application. Each independent claim recites method or apparatus for: (1) storing business rules for a plurality of companies having on-line resources; (2) identifying a company associated with the requested on-line resource from among the plurality of companies; (3) retrieving the stored business rules for the identified company; and (4) determining whether the stored business rules for the identified company associated with the requested on-line resource indicate that authentication for the user is required.

In concluding that the combination of Pereira and Viavant renders the claimed invention obvious, the Examiner finds that Pereira teaches access to a specific group of objects (Ans. 7); that the access control rules of Pereira are stored associating a company with a requested online resource from among a plurality of companies [A, B, or C] (Ans. 8); and that while Pereira teaches that the rules are applied to users, they are also the rules for the companies involved (Ans. 8). The Examiner further finds that Viavant teaches determining if authentication is required, and “authentication methods in” (Ans. 9).

We do not agree with the Examiner’s findings that Pereira and Viavant, taken together, teach all the limitations of claims 1, 20, and 39. Broadly stated, the instant invention is concerned with receiving requests for the use of on-line resources which may correspond to any one of a *plurality* of different companies, determining for each request whether the business rules corresponding to that particular company require user authentication,

and if so performing such user authentication. Pereira, on the other hand, is directed to providing an extranet user access to an object located in a foreign intranet (FF 2). Pereira is concerned with who may be granted access to a *single company's* data; those granted access may be internal or external to that single company. To reduce the replication of profile records across intranets, the inventive profiling database may include records for *users* from different companies (FF 3; emphasis added). The Examiner correctly finds that Pereira teaches a database having a "Company" attribute (Ans. 7; Pereira Fig. 1). However, that attribute is attached to each of a plurality of *users*, rather than a plurality of stored data objects to be accessed by users. The Examiner's finding that Pereira teaches access to an online resource "from among a plurality of companies" (Ans. 8) is erroneous. The Examiner's statement that an online resource may be associated with "company A, B, or C" (Ans. 8) lacks support in the record. We have reviewed Pereira and find no teaching that the on-line resources therein may be associated with one of a plurality of companies.

Thus, we find that Pereira lacks a teaching of on-line resources corresponding to a plurality of companies. Because Pereira is directed to managing a single company's data, Pereira necessarily lacks a teaching of identifying which company corresponds to a particular resource request; retrieving the business rules for the identified company; or determining whether authentication is required before granting access to the identified company's resources.

Because Pereira lacks a teaching of the claim limitations discussed *supra*, we find error in the Examiner's prima facie case of obviousness over

Pereira in view of Viavant. Therefore, we will not sustain the rejection of claims 1, 4-6, 18-20, 23-25, 37-39, and 45 under § 103.

CLAIMS 2, 7, 8, 21, 26, 27, 40, AND 43

As explained *supra*, we reversed the rejection of claims 1, 20, and 39, from which claims 2, 7, 8, 21, 26, 27, 40, and 43 variously depend. We have reviewed Baulier, and find that it does not remedy the deficiencies noted with respect to the combination of Pereira and Viavant. Thus, we will not sustain the rejection of claims 2, 7, 8, 21, 26, 27, 40, and 43 under § 103, for the same reasons given with respect to claims 1, 20, and 39, *supra*.

CLAIMS 10-16 AND 29-35

As explained *supra*, we reversed the rejection of claims 1 and 20, from which claims 10-16 and 29-35 variously depend. We have reviewed Blonder, and find that it does not remedy the deficiencies noted with respect to the combination of Pereira and Viavant. Thus, we will not sustain the rejection of claims 10-16 and 29-35 under § 103, for the same reasons given with respect to claims 1 and 20, *supra*.

CLAIMS 46-51

As explained *supra*, we reversed the rejection of claims 1, 20, and 39, from which claims 46-51 variously depend. We have reviewed Baulier and Spiegel, and find that they do not remedy the deficiencies noted with respect to the combination of Pereira and Viavant. Thus, we will not sustain the rejection of claims 46-51 under § 103, for the same reasons given with respect to claims 1, 20, and 39, *supra*.

*New Grounds of Rejection of claim 1*

We make the following new grounds of rejection using our authority under 37 C.F.R. § 41.50(b).

Claim 1 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

We have reviewed the steps recited in method claim 1 and find that none of the steps tie the method to a particular machine or apparatus. We further find that the method of claim 1 does not transform an article into a different state or thing. We therefore find that claim 1 is not tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. *Bilski*, 545 F.3d at 954. Thus, we conclude that claim 1 is directed to non-statutory subject matter under § 101.

Although we decline to reject every claim under our discretionary authority under 37 C.F.R. 41.50(b), we emphasize that our decision does not mean the remaining claims are patentable. Rather, we merely leave the patentability determination of the remaining claims to the Examiner. *See* MPEP § 1213.02.

### CONCLUSIONS OF LAW

Appellants have shown that the Examiner erred in finding that Pereira teaches controlling access by users to on-line resources of a *plurality of companies*, including storing business rules for a plurality of companies having on-line resources; identifying a company identified with a requested on-line resource from among the plurality of companies; retrieving the stored business rules for the identified company; and determining whether stored business rules for the identified company associated with the requested on-line resource indicate that authentication for the user is required.

ORDER

The Examiner's rejection of claims 1, 2, 4-8, 10-16, 18-21, 23-27, 29-35, 37-40, 43, and 45-51 is reversed.

We have also entered a new ground of rejection against claim 1 under 37 C.F.R. § 41.50(b).

37 C.F.R. § 41.50(b) provides that, "[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

(2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.1.36(a).

Appeal 2009-006015  
Application 09/801,468

REVERSED

37 C.F.R. § 41.50(b)

ELD

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